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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,297	01/10/2006	Job Cornelis Oostveen	NL 030807	7965

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EXAMINER

PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2435

MAIL DATE	DELIVERY MODE
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10/26/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,297	Applicant(s) OOSTVEEN ET AL.	
	Examiner PONNOREAY PICH	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 5-7 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-14 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election of group I (claims 1-4, 8-14, and 18-21) in the reply filed on 8/10/09 is acknowledged. Because applicant did not distinctly and specifically point out any supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Information Disclosure Statement

Regarding the IDS submitted on 9/18/07, the PG-Publication to Levy (US 2002/0011844) was not considered because it appears the wrong serial number is given for the document. The document having serial number 2002/0011844 is not related to Levy et al. All other documents listed were considered.

Claim Objections

Claims 2-4, 8-10, 12-14, and 18-20 are objected to because of the following informalities:

1. Regarding claims 2-4 and 8-10, "A method" as recited in the preamble should be "The method".
2. Regarding claims 12-14 and 18-20, "A device" as recited in the preamble should be "The device".
3. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4, 8-14, and 18-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 1, 4, 11, and 14 refer to the segment of the multimedia signal being "unambiguously" related with the given trigger time point. However, "unambiguously" is a relative term which the specification fails to provide proper guidance for determining the requisite degree, thus the metes and bounds of the claims cannot be determined. What is unambiguously related to one person may not necessarily be unambiguously related to another person. The specification as originally filed fails to provide adequate guidance with respect to how to determine whether a signal is "unambiguously" related and it does not appear that without proper guidance, one of ordinary skill would be able to make a proper determination since the specification appears to define whether or not a signal is unambiguously related via use of another relative term which the specification also fails to provide proper guidance for determining the requisite degree. For example, in the next to last paragraph on page 5 of the specification, it is stated that a signal is unambiguously related by letting the segment of the multimedia signal end "substantially" at the given time point. "Substantially" is itself a relative term that applicant has failed to provide proper guidance for determining the requisite degree.
2. The term "substantially" in claims 4 and 14 is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the

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specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. As such, it is unclear how close in time a multimedia signal must end or start at a given trigger time point to be considered "substantially" at the given trigger time point.

3. Regarding claims 9 and 19, the phrase "e.g." renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
4. Claims 10 and 20 recites "the second database" which lack antecedent basis.
5. Claims not specifically addressed are rejected due to dependency.
6. Art rejection will be applied to the claims as best understood.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 21 is directed towards a "computer readable medium". The specification fails to disclose what types of media are meant to be encompassed by "computer readable medium"; as such, the term has been broadly, but reasonably interpreted to mean that it also encompasses signals. Note that signals do not fall within any of the

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four statutory categories of invention, thus claim 21 is not statutory. **Clarification is requested as to what is meant to be encompassed by "computer readable medium".**

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-14, and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhoads et al (US 2002/0032864).

Claims 1, 11, and 21:

As per claim 1, Rhoads discloses a method comprising the steps of:

1. Providing at least one trigger time point (T.sub.n; T.sub.n+1) and for each trigger time point (T.sub.n; T.sub.n+1) providing at least one representation of least one associated trigger action (105), where each trigger time point (T.sub.n; T.sub.n+1) indicates a time point of the multimedia signal (101) for which the at least one associated trigger action is to be available during playback of the multimedia signal (101) (paragraphs 14, 21, 27, and 30-33).
2. For each given trigger time point (T.sub.n; T.sub.n+1) deriving a fingerprint (102) on the basis of a segment of the multimedia signal (101), where the segment of

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the multimedia signal (101) is unambiguously related with the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$) (paragraphs 14 and 21).

3. Associating the derived fingerprint (102) with the at least one associated trigger action (paragraphs 22 and 27).

Claims 11 and 21 are directed towards a device and computer readable medium respectively which implements the method of claim 1. Claims 11 and 21 are rejected for much the same reasons as claim 1.

Claims 2 and 12:

As per claim 2, Rhoads further discloses for each obtained trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$), storing the derived fingerprint (102) and the at least one representation of the at least one associated trigger action (105) in a first database (203) (paragraphs 27 and 30-31).

Claim 12 is directed towards a device which implements the method of claim 2 and is rejected for much the same reasons.

Claims 3 and 13:

As per claim 3, Rhoads further discloses that the one or more derived fingerprints (102) and/or the at least one representation of at least one associated trigger action (105) for the multimedia signal (101) is transmitted to a playback-device (300) via the Internet or in a side-channel of a broadcast channel or via some other channel or means (paragraph 27).

Claim 13 is directed towards a device which implements the method of claim 3 and is rejected for much the same reasons.

Claims 4 and 14:

As per claim 4, Rhoads further discloses that the segment of the multimedia signal (101) is unambiguously related with the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$) according to: the segment of the multimedia signal (101) ending substantially at the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$), the segment of the multimedia signal (101) starting substantially at the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$), the segment of the multimedia signal (101) starting or ending at a predetermined distance before or after the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$), or the given trigger time point ($T_{\text{sub}.n}$; $T_{\text{sub}.n+1}$) being at a predetermined time point between a start and an end of the segment of the multimedia signal (101) (paragraphs 14 and 21).

Claim 14 is directed towards a device which implements the method of claim 4 and is rejected for much the same reasons.

Claims 8 and 18:

Rhoads further discloses that said multimedia signal (101) is an audio signal, a video signal or a combined audio/video signal (paragraph 27—i.e. a song is an audio signal).

Claims 9 and 19:

Rhoads further discloses that said at least one associated trigger action (105) is selected from the group of: retrieving and displaying additional information on a display,

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retrieving and playing additional information via a speaker, playing another multimedia signal instead of said multimedia signal (101) for a predetermined or variable period of time, stopping/pausing, e.g. temporarily, display/play, executing other control commands, and/or preparing the system for user inputs (paragraph 27).

Claims 10 and 20:

Rhoads further discloses that the derived fingerprint (102) and/or the fingerprint (102) in the second database (203') is an audio and/or video fingerprint (102) (paragraphs 14 and 21).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 11, 10, 20, 3, 13, 4, 14, 8, 18, and 21 are provisionally rejected on the ground of nonstatutory double patenting over claims 1, 15, 2, 16, 3, 17, 4, 18, 14, 28, and 29 respectively of copending Application No. 10/566,003. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The above claims of the '003 application are anticipated by the above claims of the current application

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is (571)272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Primary Examiner, Art Unit 2435